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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/682,519	09/13/2001	Yu Wang	040489-0177	2614
22428	7590	10/27/2005	EXAMINER	
FOLEY AND LARDNER LLP			DONOVAN, LINCOLN D	
SUITE 500			ART UNIT	
3000 K STREET NW			PAPER NUMBER	
WASHINGTON, DC 20007			2832	

DATE MAILED: 10/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/682,519

Applicant(s)

WANG ET AL.

Examiner

Lincoln Donovan

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22,39 and 40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22,39 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10-06-05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103[a] which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 7-11, 14, 19-21 and 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laskaris et al. [US 6,198,371] in view of Kim [US 6,336,794] and Aoki et al. [US 2003/0020578].

Laskaris et al. disclose an open magnet assembly with a floor mount comprising:

- a first assembly [12] mounted about a first longitudinally-extending and generally-vertically-aligned axis including:
 - at least one superconducting main coil [24] positioned around the axis; and
 - a vacuum enclosure [26] enclosing the at least one superconductive main coil;
- a second assembly [14] mounted about a second longitudinally-extending and generally-vertically-aligned axis coaxially aligned with the first axis and spaced longitudinally apart from and disposed below the first assembly, the second assembly including:
 - at least one superconducting main coil [30] positioned around the axis; and
 - a vacuum enclosure [26] enclosing the at least one superconductive main coil;
- at least one support beam [16, 18] external to the first and second vacuum enclosures having

a first end attached to the first assembly and a second end attached to the second assembly; and

- a support apparatus [20] supporting both assemblies from a floor [42].

Laskaris et al. discloses the instant claimed invention except for the support apparatus providing vibration isolation and the specific isolation system used and the second assembly being supported by only two support members not diametrically aligned to a diameter line of the first and second assemblies.

Kim discloses an vibration isolation system [figure 1] with a plurality of isolators [40] for a piece of machinery [10].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a vibration isolation system for the support structure of Laskaris et al., as suggested by Kim, for the purpose of reducing vibration of the open magnet assembly.

Aoki et al. discloses a magnetic field generator having first and second magnets [14a, 14b] supported by only two support members not diametrically aligned to a diameter line of the first and second assemblies [figure 1].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the support design of Aoki et al. for the magnet system of Laskaris et al., in order to facilitate access to the interior of the device.

Kim discloses the vibration isolation system mounted on a floor assembly [50] supporting a support member [30] supporting the machinery away from the floor structure [figure 1].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the isolation support mounting design of Kim in Laskaris et al., as modified, for the purpose of isolating the device from the floor structure.

The specific footprint of the isolation system and its use as a retrofit would have been an obvious design considerations for the purpose of reducing space usage and costs.

Claims 2-4, 12-13, 15-17 and 22 are rejected under 35 U.S.C. 103[a] as being unpatentable over Laskaris et al., as modified, as applied to claims 1, 7-11, 14 above, and further in view of Ohsaki [US 6,202,492].

Laskaris et al., as modified, discloses the instant claimed invention except for the isolators being adjustable and actively pneumatically controlled.

Ohsaki discloses a surface [6] being supported by adjustable actively controlled pneumatic isolators [4a-d, column 5, lines 1-12].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to the isolator design of Ohsaki for the isolators of Laskaris et al., as modified, for the purpose of accommodating variations in the operating environment.

The specific frequencies, Q-factors, bandwidth, etc. of the control would have been obvious design considerations based on the specific application and environment of use.

Claims 5-6 and 18 are rejected under 35 U.S.C. 103[a] as being unpatentable over Laskaris et al., as modified, as applied to claims 1 and 14 above, and further in view of Braun [US 4,781,363].

Laskaris et al., as modified, discloses the instant claimed invention except for the use of balance weights on the isolators.

Braun discloses the use of balance weights [9] mounted on an isolator.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use balance weights on the isolators of Laskaris et al., as modified, for the purpose of accommodating unexpected balance shifts.

It would have been obvious to have the amount of weight applied be adjustable for the purpose of accommodating varying operating environments.

Response to Arguments

Applicant's arguments filed 08-10-05 have been fully considered but they are not persuasive.

Applicant argues:

1]: Laskaris teaches away from the claimed invention since Laskaris teaches a rigidly mounted magnet assembly not having a vibration isolation system.

2]: Kotani only teaches mounting a refrigeration system of an MRI device.

3]: There would have been no motivation to combine the teachings of Kotani with Laskaris.

4]: The specific footprint of the isolation system would not have been an obvious design consideration.

5]: Examiner uses hindsight to combine Laskaris with Kotani and Ohsaki et al.

6]: There would have been no motivation to combine Laskaris with Braun et al.

Examiner disagrees:

Regarding 1-3: Laskaris teaches, as acknowledged by applicant, arguments page 6, the claimed MRI device being mounted to minimize vibration. Kotani teaches mounting a piece of heavy equipment used with an MRI system using a vibration isolation system similar to that claimed by applicant. A skilled artisan would have been motivation to use the vibration isolation system of Kotani for the rigid attachment design of Laskaris in order to further reduce unwanted vibration.

Regarding 4: Applicant has not claimed any specifics of the footprint of the system other than that the MRI magnet system is "attached over the vibration isolation system." A skilled artisan would modify an isolation system for an MRI to accommodate the specific MRI system used.

Regarding 5: In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Regarding 6: In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so

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found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as exhibited by the various isolation systems shown by the prior art, a skilled artisan would reasonably combine isolation systems from various other support systems for isolating heavy equipment, such as an MRI system.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

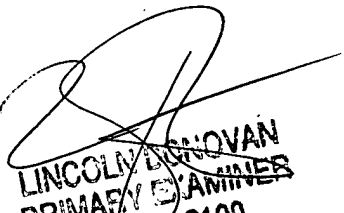
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lincoln Donovan whose telephone number is 571-272-1988. The examiner can normally be reached on M-F 8-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin Enad can be reached on 571-272-1990. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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